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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,589	11/24/2003	Francis J. Marentic	I26.12-0003	5782

27367 7590 07/14/2008
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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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07/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/721,589

Applicant(s)

MARENTIC ET AL.

Examiner

Betelhem Shewareged

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,6,7,9,10,41-47 and 49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1,4,6,7,9,10,41-47 and 49 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's response filed on 11/20/07 has been fully considered. The Claim Objections have been withdrawn in view of Applicant's amendments and comments.
2. Claims 1, 6, 7, 42, 43 and 47 are amended, claims 2, 3, 5, 8, 11-40 and 48 are canceled, and claims 1, 4, 6, 7, 9, 10, 41-47 and 49 are pending.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
4. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.
5. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
6. Claims 1, 4, 6, 7, 9, 10, 41-47 and 49 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-4 and 6 of U.S. Patent No. 6,682,679 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because current claim 1 corresponds to a combination of claims 1 and 2 of '679, where the process of claims 1 and 2 of '679

Art Unit: 1794

forms the decorative sheet of current claim 1 having all the layers. Current claim 4 corresponds to claim 4 of '679. Current claims 6, 9 and 45 correspond to claim 3 of '679 in view of col. 7, line 23 of '679, where the ink film comprises isophthalic/neopentyl glycol. Current claim 10 corresponds to claim 6 of '679, where the ink film contains tack-free resin (or tack reducers). Current claim 41 corresponds to a combination of claims 1 and 2 of '679, where the process of claims 1 and 2 of '679 forms the decorative sheet of current claim 41 having all the layers. Current claim 42 corresponds to a combination of claims 1 and 2 of '679, where the process of claims 1 and 2 of '679 forms the decorative sheet of current claim 42 having all the layers. Current claim 43 corresponds to a combination of claims 1 and 2 of '679, where the process of claims 1 and 2 of '679 forms the decorative sheet of current claim 43 having all the layers. Current claim 44 corresponds to a combination of claims 1 and 2 of '679, where the process of claims 1 and 2 of '679 forms the decorative sheet of current claim 44 having all the layers. Current claim 46 corresponds to claim 6 of '679, where the ink film contains tack-free resin (or tack reducers). Current claim 47 corresponds to a combination of claims 1 and 2 of '679, where the process of claims 1 and 2 of '679 forms the decorative sheet of current claim 47 having all the layers. Current claim 49 corresponds to a combination of claims 1 and 2 of '679, where the process of claims 1 and 2 of '679 forms the decorative sheet of current claim 49 having all the layers.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is (571)272-1529. The examiner can normally be reached on Monday-Friday 9am-5pm.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BS
January 20, 2008.

A handwritten signature in black ink, consisting of stylized letters 'B' and 'S' with a flourish underneath.